

REMARKS

1. Status of Claims

Claims 1-20 were pending in the application. Applicants have amended claims 1, 2, 7 and 8 and canceled claim 17 without prejudice or disclaimer. A Request for Continued Examination (RCE) is filed herewith. Applicants respectfully request entry of the above amendments and consideration of the enclosed remarks. Applicants submit that no new matter is added. Accordingly, claims 1-16 and 18-20 will remain pending in the application.

2. Examiner's Response to Arguments

In section 5 of the Office Action, the Examiner disagreed with Applicants argument regarding the improper use of inherency. Applicants again dispute the alleged findings of inherency.

Of the 7 subparagraphs (herein, items) of claim 1, the Examiner alleges that only 1 is found explicitly in the primary reference Watts '186. The Examiner then alleges that the next 5 items are inherently found in Watts '186 apparently without describing why such items must be present in the teachings of Watts '186, but apparently allegations suggesting that they could be. The Examiner admits that the 7th item is not taught or suggested by Watts '186.

The examining procedure for establishing inherency is described in MPEP 2112. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'

For example, with regard to the 5 items that the Examiner claims would be inherent in Watts '186 as applied to claim 1, it is not at all inherent that the claimed notification system for defining and storing notifications would be used since Watts '186 does not create a list of notifications for presentation to the user. In fact, the Examiner apparently admits on the bottom of page 3 of the Office Action that Watts '186 does not teach or suggest providing such a new notification to a notification manager as claimed.

Also in section 5 of the Office Action, the Examiner disagreed with Applicants argument regarding the improper combination of references and Applicant addresses that issue below.

Furthermore, Claims 1, 7 and 17 have been amended to further recite the needed inputs are provide by the user and therefore, the Applicants respectfully request reconsideration.

3. Rejections under 35 USC § 103(a)

In section 4 of the Office Action, the Examiner rejected Claims 1-20 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,119,186 to Watts, et al. ("Watts '186") in view of U.S. Patent Application Publication No. 2004/0061716 A1 by Cheung, et al. ("Cheung '716").

Applicants respectfully traverse the rejection. However, solely in order to expedite prosecution, Applicants have amended the claims 1, 2, 7 and 8 to recite further limitations distinguishing the cited references and accordingly, the rejection is moot. Applicants have canceled claim 17.

Applicants respectfully submit that the combination of references is improper. For example, the Examiner states that the reason for the combination is to allow notifications to be viewed and managed by a user as desired in a clear instance if impermissible hindsight. Watts '186 does not teach or suggest a list of notifications or any possibility of delayed response to such notifications. While that problem is appreciated and successfully overcome in the teachings of the present application, it is not a problem appreciated in the art. In Watts '186, the author describes a system of static, serial state change prompts (See Fig. 5B) in which the system waits for a

prompt and sits in a single state loop until a response is received. One of skill in the art would not look to a system for managing a plurality of notices such as in Cheung '716, since the system must serial wait for a response to each prompt. Accordingly, Applicants respectfully submit that the combination is not proper and request that the Examiner withdraw the rejection.

With regard to claim 1, the cited references do not alone or in proper combination teach or suggest at least:

defining response descriptions for the needed response instance having needed inputs in an application model;

...
“wherein the notification manager is configured to receive a plurality of new notifications for a user received over time and to receive response to the plurality of the new notifications from the user at the convenience of the user,

then continuing processing in the first configuration until the at least one response is received from the user”.

With regard to independent claim 7, the cited references do not alone or in proper combination teach or suggest at least:

“and continuing processing in the first configuration until the user responds”

Furthermore, with respect to claim 7, it is clear that the allegedly inherent teachings are not inherent as they are admitted to be mere possibilities for the reference and thus not inherent material.

With respect to dependent claims 2 and 8, the cited references do not teach or suggest receiving data input from the user in response to the notification.

The additional dependent claims are patentable over the cited references for at least the reasons described above with regard to the respective independent claim and any intervening claims.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection and respectfully submit that claims 1-16 and 18-20 are in condition for allowance.

4. Conclusion Of Remarks

For at least the reasons stated above, it is respectfully submitted that the claims of this application are in condition for allowance and early and favorable action thereon is requested.

If the Examiner believes that additional issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned attorney for Applicant at (203) 924-3180.

5. Authorization

No fee is believed due with this Communication. However, the Commissioner is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-822-O1.

In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely. The Commissioner is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-822-O1.

Respectfully submitted,

/George M. Macdonald/

George M. Macdonald
Reg. No. 39,284
Attorney of Record
Telephone (203) 924-3180
PITNEY BOWES INC.
Intellectual Property and Technology Law Department
35 Waterview Drive, P.O. Box 3000
Shelton, CT 06484-8000